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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,907	12/12/2003	Richard J. Roesgen	28952.5667	2303
27890	7590	05/03/2007		
STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			EXAMINER HUNTER, ALVIN A	
			ART UNIT 3711	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/734,907

Applicant(s)

ROESGEN ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of claims 6 and 8 are is withdrawn in view of the newly discovered reference(s) to Cheng (USPN 5967903), Buck (USPN 5779560), Chen (USPN 5403007), Stubbs et al. (USPN 6080215), and Shira (USPN 768787).

Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (USPN 5403007) in view of Shira (USPN 4768787) and Stubbs et al. (USPN 6080215), Buck et al. (USPN 5779560) and Kobayashi (USPN 4754971).

Regarding claim 1, Chen discloses a metal club head having a face wherein the face is made of a ceramic material. Chen does not disclose the ceramic being silicon carbide. Shira discloses a club head having high friction wherein silicon carbide is incorporated and noted as a material. Stubbs et al. discloses an abrasive article wherein silicon carbide is incorporated and noted as being abrasive by nature. Further, Buyck et al. shows a club head having a laminate layer of a ceramic made of silicon carbide incorporate into the face plate of the club head. Therefore, one having ordinary skill in the art would have found it obvious to incorporate silicon carbide as the face

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plate material because it is abrasive by nature, thus increasing the backspin of a golf ball. It is submitted that the values of the hardness and the roughness need not be explicitly found being that the combination teaches both increase in rigidity and increase in spin. Kobayashi discloses a set of iron club head wherein backspin is related to the loft angle of the club head. One having ordinary skill in the art would have found it obvious to have the club head of Chen with a loft greater than 45 degrees, in order to increase backspin.

Regarding claim 2, see the above regarding claim 1,

Regarding claim 4, see the above regarding claim 1.

Regarding claim 5, see the above regarding claim 1.

Regarding claim 7, as noted above the surface roughness would not bear any importance on a material that it abrasive by nature.

Regarding claim 8, see the above regarding claim 1.

Regarding claim 9, see the above regarding claim 1.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Cheng (USPN 5967903) in view of Shira (USPN 4768787) and Stubbs et al. (USPN 6080215), and Kobayashi (USPN 4754971).

Regarding claim 3, Cheng discloses a metal club head having a face wherein the face is made of maraging steel. Cheng does not disclose increase backspin. Shira discloses a club head having high friction wherein silicon carbide is incorporated and noted as a material. Stubbs et al. discloses an abrasive article wherein silicon carbide is incorporated and noted as being abrasive by nature. Therefore, one having ordinary

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skill in the art would have found it obvious to incorporate silicon carbide to the face plate material because it is abrasive by nature, thus increasing the backspin of a golf ball. It is submitted that the values of the hardness and the roughness need not be explicitly found being that the combination teaches both increase in rigidity and increase in spin. Kobayashi discloses a set of iron club head wherein backspin is related to the loft angle of the club head. One having ordinary skill in the art would have found it obvious to have the club head of Chen with a loft greater than 45 degrees, in order to increase backspin.

Response to Arguments

Applicant's arguments with respect to claims 1-5 and 7-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 571-272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached at 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.



EUGENE KIM
SUPERVISORY PATENT EXAMINER